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EXAMINER
CHANKONG, DOHM

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/891,264	GYS, LUDO
	Examiner	Art Unit	
	DOHM CHANKONG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 August 2008</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-20</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☐ All   b) ☐ Some * c) ☐ None of:
         1. ☐ Certified copies of the priority documents have been received.
         2. ☐ Certified copies of the priority documents have been received in Application No. _____.
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to Applicant's amendment and arguments filed on 8/8/2008.

Claims 1 and 7-11 are amended. Claims 18-20 are added. Thus, claims 1-20 are presented for

further examination.

2.   This action is a non-final rejection.

Response to Arguments

3.   As will be further discussed below, claims 8, 10, 11, 14, 16, 17, and 20 are rejected under

§101 for being directed towards non-statutory subject matter. Because this rejection is a new

ground of rejection and it was not necessitated by Applicant's amendment, this action is made

non-final to give Applicant an opportunity to address the rejection.

4.   Independent claims 1 and 7-11 have been amended. Claim 1 is amended with a new

limitation reciting that the provisioning of the personal service to a communication means occurs

via a communication network. Yates discloses this new limitation in the form of providing

services to a user terminal via the network [*Figure 1 | column 15 «lines 41-63»*: providing

services to the user's terminal].

Claims 7-11 are merely cosmetically amended with no substantive limitations that affect

their scope. Applicant argues that the cited prior art references, Yates and Beck, do not disclose

the claimed invention and in particular the claimed service machine. Applicant's ultimate point

seems to be that "[a] service machine is something that, when executed, provides a service" and

Yates' modules (or SIBBs) cannot read on the claimed machine because they do not provide any services. According to Applicant, only Yates' software agent may read on the claimed service machine. Contrary to this argument, Yates clearly states that "SIBBs are units of both information and functionality *that provide the services* to other agents or users" [*column 18 «lines 40-42»*]. One example of a service that a SIBB may provide is "called an Accounter, which gives subscribers an account enquiry" [*column 18 «lines 48-50»*]. Thus, contrary to Applicant's argument, it is clear from these citations that Yates' SIBBs do provide services to user terminals. Despite this clear evidence to the contrary, Applicant reasons that "[a]n SIBB cannot possibly [provide a service] or it could not be 'service-independent' as its name requires."

Applicant's argument presumes that Yates only teaches providing a single service and that the SIBBs are only part of the software agent that provide this single service. Applicant's argument ignores the fact that Yates discloses a service that contains *other* services. For example, an overall service for providing video-on-demand [*column 3 «lines 8-10»*]. Within that overall service are other services such as providing Help support or "View-Charges" capability [*column 3 «lines 10-15»*]. Coupled with the citations above, it is clear that the SIBBs by executing various rules and policies provide individual services. A user may aggregate the SIBBs to form a larger server that comprises these individual services.

In any event, Applicant's argument simply rehashes a similar argument made in Applicant's appeal brief, filed on 12/14/2005. In its decision on 11/16/2006, the Board found this argument to be unpersuasive. [*Bd. Decision*, *pgs. 9-10]*. There, the board found that the "SIBBs-type software module qualifies as the claimed 'service container' because it contains the individual SIBBs." Implicit in this finding is the assumption that the individual SIBBs qualify as

the claimed service machine because the claim required the service container to contain or

encapsulate a service machine.

Applicant is therefore essentially requesting the examiner to change the ground of

rejection despite the Board's implicit finding contradicting Applicant's argument. Because the

scope of the claims have not been changed since the current ground of rejection was affirmed by

the Board, the examiner will not change the ground of rejection until: (1) Applicant amends the

claims with new limitations that alter the claims' scope or (2) the Board reconsiders its position

of the current claims in light of Applicant's arguments and reverses the rejection. If Applicant

believes the Board's decisions to be in error and that the claims are allowable as they are

currently written, then the proper course of action is not to squabble with the examiner using

already considered arguments but to request review of the decision by the Court of Appeals for

the Federal Circuit. *See MPEP 1216.*

5.   Claims 18-20 have been added. As will be further discussed below, Yates discloses the

limitations of each of these claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

6.   Claims 8, 10, 11, 14, 16, 17, and 20 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. Claims directed to software *per se* are

rejected under §101 because software *per se* is neither a process, machine, manufacture, or

composition of matter. To qualify as a machine, at least one element within a claim must be a

physical part of a device. For example, a system claim that comprises nothing but software

modules would be software *per se*. But if the system were amended to include for example, a

monitor to display an interface as well as the modules, the system would clearly be a machine as

it contains a physical element.

Here, both claims 8 and 10 are directed to service modules. Claim 8's module comprises

program code, receiving means, network lock means, and execution means. Claim 10's module

comprises program code, receiving means, provision means, and transmission means.

Applicant's specification is silent as to whether these modules are implemented as hardware

elements (and hence would be considered a machine) or as purely software components.

Therefore, the term is given its broadest reasonable interpretation consistent with the

specification. The specification describes receiving means and the execution means as software

[*US Patent Publication 20020003868*, 0019 – software "execution engine", 0027 – ORB binding

software]. Further, it was well known in the art that modules are may be implemented as purely

software programs or as hardware elements. *See Microsoft Computer Dictionary, Fifth Edition,*

pg. 346. Because the claimed service modules may reasonably be interpreted as software *per se*,

claims 8 and 10 and their dependent claims are directed towards non-statutory subject matter.

Claim 11 is directed towards a first service container. These containers are clearly

software only applications [*US Patent Publication 20020003868*, 0019 - containers are

transmitted over a network from the server to the client]. Therefore, claim 11 and its dependent

claims are directed to software *per se* as well and fails to fall within a statutory category.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1-20 are rejected under 35 U.S.C § 103(a) as being unpatentable over Yates et al,

U.S Patent No. 6.330.586 ["Yates"], in view of Beck et al, U.S Patent No. 6.604.140 ["Beck"].

8.   As to claim 1, Yates discloses a method for providing personal services for a

communication means of a user, said communication means being connected to a

communication network, the method comprising the steps of:

execution by said service computer of said service machine, said service machine

managing the execution of a personal service for said communication means [column 2 «lines

60-65» | column 3 «lines 5-15 and 21-23» | column 29 «line 63» to column 30 «line 9» where:

Yates' module are analogous to the service container, the module's code and SIBBs are

analogous to a service machine];

provision by said service computer of at least one network lock for said first service

container, said at least one network lock offering to said first service container a predefined

interface to said communication network for the provision of said personal service [column 6

«lines 38-45» | column 9 «lines 1-7» | column 10 «lines 1-16» where: Yates' interfaces are

comparable in functionality to the network lock and Yates' terminal domain is analogous to the

service computer]; and

      provision of said personal service to said communication means via said communication

network by execution or by application by said service machine of at least one service

component being transmitted to said service computer via said first service container or via a

second service container [abstract | column 4 «lines 41-55» | column 15 «lines 20-23» | column

17 «lines 33-48» | column 23 «lines 29-41» | column 26 «lines 60-63» | claim 1 where: execution

of code in the software module provides the personal service to the terminal in Yates' system] .

      Yates does disclose a first service container encapsulating a service machine

available to a service computer [abstract | column 2 «line 66» to column 3 «line 15» | column 15

«lines 17-23» where Yates' modules is analogous to the service container and the code of the

module and the SIBBs are analogous to a service machine | see also BPAI's decision on

reconsideration, pg. 5, ¶1], but does not specifically disclose transmission of the container by a

service server. However, such a feature was well known in the art at the time of Applicant's

invention. For example, Beck discloses a method for providing personal services including

transmission by a service server of a first service container to a service computer [abstract |

column 1 «lines 65-67» | column 2 «lines 1-3 and 16-20» | column 6 «lines 13-24» | column 7

«lines 26-44» | claim 66 where: Beck's service code is analogous to a service container]. It

would have been obvious to one of ordinary skill in the art to incorporate the functionality of

Beck's dynamic transmission of the service container into Yates' service provisioning system to

allow service containers to be dynamically loaded and utilized by terminals. One would have

been motivated to perform such an implementation to obtain the benefits of minimizing

consumption of device resources by the terminals.

9.   As to claim 2, Yates discloses the method as claimed in claim 1, further comprising the

step of: the service computer providing at least one monitor lock for said first service container,

and said first service container informing the service server via said monitor lock of a condition

of the service computer [column 9 «lines 1-7» | column 15 «lines 8-12» where: Yates discloses

notifications are transmitted between objects, one object being the service server, another

representing the service computer].

10.   As to claim 3, Yates discloses the method as claimed in claim 1, further comprising the

steps of: the service computer providing at least one management lock for said first service

container, and said first service container sends alarms via said management lock to an operator

terminal or a network management system [column 10 «line 64» to column 11 «line 4»].

11.   As to claim 4, Yates discloses the method as claimed in claim 1, characterized in that said

terminal sends a request for said service to the service server [column 25 «lines 41-61»].

12.   As to claim 5, Yates discloses the method as claimed in claim 1, characterized in that it is

carried out in an Intelligent Network representing said communication network [column 8 «lines

30-39»].

13.   As to claim 6, Yates discloses the method as claimed in claim 1, characterized in that the

service container provides the resource lock for said first service container, said resource lock

offering to said first service container an application program interface and/or an interface

towards a special resource point and/or an interface towards a service program interface [column

3 «lines 37-59» | column 9 «lines 1-7»].

14.   As to claim 7, Yates discloses a service computer for providing personal services for a

communication means of a user, said communication means being connected to a

communication network, said service computer comprising:

        network lock means designed such that the service computer can provide at least one

network lock for said first service container, said at least one network lock offering to said first

service container a predefined interface to said communication network for provision of a

personal service for said communication means [column 6 «lines 38-45» | column 9 «lines 1-7» |

column 10 «lines 1-16» where: Yates' terminal domain system is comparable in functionality to

the service computer]; and

        execution means designed such that the service computer can execute said service

machine, said service machine managing the provision of said personal service for said

communication means and said service machine executing or applying at least one service

component for provision of said personal service, said service component being transmitted to

said service computer via said first service container or via a second service container [abstract |

column 2 «lines 60-65» | column 3 «lines 5-15 and 21-23» | column 4 «lines 41-55» | column 15

«lines 33-40» | column 26 «lines 60-63» | column 29 «line 63» to column 30 «line 9» | claim 1].

Yates does disclose a receiving means for the service computer [column 26 «lines 60-63»] but does not specifically disclose said receiving means for receiving of a first service container encapsulating a service machine from a service server. However, such a feature was well known in the art at the time of Applicant's invention. For example, Beck discloses a service computer comprising a receiving means for receiving of a first service container containing a service machine from a service server [abstract | column 1 «lines 65-67» | column 2 «lines 1-3 and 16-20» | column 6 «lines 13-24» | column 7 «lines 26-44» | claim 1 where: Beck's service code is analogous to a service container, Beck's first device is analogous to a service computer, and second device is analogous to a service server]. It would have been obvious to one of ordinary skill in the art to incorporate the functionality of Beck's dynamic transmission of the service container into Yates' service provisioning system to allow service containers to be dynamically loaded and utilized by terminals. One would have been motivated to perform such an implementation to obtain the benefits of minimizing consumption of device resources by the terminals.

15.   As to claim 8, Yates discloses a service computer module for a service computer for providing personal services for a communication means of a user, said communication means being connected to a communication network, said service computer module comprising:

program code able to be executed by a control means of the service computer [column 2 «lines 57-65»];

network lock means by which the service computer can provide at least one network lock for said first service container, said at least one network lock offering to said first service

container a predefined interface to said communication network for provision of a personal

service for said communication means [column 3 «lines 37-59» | column 6 «lines 38-45» |

column 9 «lines 1-7» | column 10 «lines 1-16»]; and

      execution means by which the service computer can execute said service machine, said

service machine managing the provision of said personal service for said communication means

and said service machine executing or applying at least one service component for provision of

said personal service, said service component being transmitted to said service computer via said

first service container or via a second service container [column 2 «lines 57-65» | column 3

«lines 5-15 and 55-59» | column 26 «lines 60-67» | claims 1 and 2].

      Yates does disclose a service module and a service container encapsulating a service

machine but does not specifically disclose receiving of a first service container from a service

server. However, such a feature was well known in the art at the time of Applicant's invention.

For example, Beck discloses a service module comprising receiving means for receiving of a

first service container containing a service machine from a service server [claims 1 and 66

where: Beck's service code is analogous to a service container]. It would have been obvious to

one of ordinary skill in the art to incorporate the functionality of Beck's dynamic transmission of

the service container into Yates' service provisioning system to allow service containers to be

dynamically loaded and utilized by terminals. One would have been motivated to perform such

an implementation to obtain the benefits of minimizing consumption of device resources by the

terminals.

16.   As to claim 9, Yates discloses a service server for providing personal services for a

communication means of a user, said communication means being connected to a

communication network, said service server comprising:

　　　　receiving means for receiving a request for a personal service for said communication

means [column 25 «lines 38-51»];

　　　　provision means for providing at least one first service container [column 26 «lines 60-

63» | column 27 «lines 12-31»], encapsulating a service machine able to manage the execution of

said personal service and said service machine further able to execute or to apply at least one

service component for said service provision, when said service machine is executed by a service

computer, said service component being contained in said first service container or in a second

service container [Figure 4 «the items located inside the coordinator analogous to service

components» | column 5 «lines 21-55» | column 17 «lines 13-20»], said at least one first service

container being adapted to make use of at least one network lock provided by said service

computer and offering to said at least one first service container a predefined interface to said

communication network [column 6 «lines 38-45» | column 9 «lines 1-7» | column 10 «lines 1-

16»]; and

　　　　Yates does disclose a service server comprising transmission means for transmission of a

service to said service computer [column 26 «lines 60-63»] but does not specifically disclose

transmitting a service container. However, such a feature was well known in the art at the time

of Applicant's invention. For example, Beck discloses a transmitting a service container to a

service computer [Figure 1 «item 102» | column 3 «lines 38-47» | claim 1]. It would have been

obvious to one of ordinary skill in the art to incorporate the functionality of Beck's dynamic

transmission of the service container into Yates' service provisioning system to allow service

containers to be dynamically loaded and utilized by terminals. One would have been motivated

to perform such an implementation to obtain the benefits of minimizing consumption of device

resources by the terminals.

17.   As to claim 10, Yates discloses a service server module for a service server for providing

personal services for a communication means of a user, said communication means being

connected to a communication network, said service server module comprising:

        program code able to be executed by a control means of the service server;

        receiving means for receiving a request for a personal service for said communication

means;

        provision means for providing at least one first service container, encapsulating a service

machine able to manage the execution of said personal service and said service machine further

able to execute or to apply at least one service component for said service provision, when said

service machine is executed by a service computer, said service component being encapsulated

in said first service container or in a second service container [Figure 4 «the items located inside

the coordinator analogous to service components» | column 5 «lines 21-55» | column 17 «lines

13-20»], and said at least one first service container being adapted to make use of at least one

network lock provided by said service computer and offering to said at least one first service

container a predefined interface to said communication network [column 6 «lines 38-45» |

column 9 «lines 1-7» | column 10 «lines 1-16»].

Yates does discloses a service server module comprising transmission means for transmission of a service to said service computer [column 4 «lines 14-35» | column 26 «lines 60-63»] but does not specifically disclose transmission of a service container to the service computer. However, such a feature was well known in the art at the time of Applicant's invention. For example, Beck discloses a service module for transmitting a service container to a service computer [Figure 1 «item 102» | column 3 «lines 38-47» | claims 1 and 66]. It would have been obvious to one of ordinary skill in the art to incorporate the functionality of Beck's dynamic transmission of the service container into Yates' service provisioning system to allow service containers to be dynamically loaded and utilized by terminals. One would have been motivated to perform such an implementation to obtain the benefits of minimizing consumption of device resources by the terminals.

18.   As to claim 11, Yates discloses a first service container for providing personal services for a communication means of a user, said communication means, being connected to a communication network,

said first service container containing program code able to be executed by a control means of a service container [column 2 «lines 57-65»];

said first service container encapsulating a service machine able to manage the execution of a personal service and said service machine further able to execute or to apply at least one service component for said service provision, when said service machine is executed by said service computer, said service component being contained in said first service container or in a

second service container [abstract | column 4 «lines 41-55» | column 15 «lines 33-40» | column 26 «lines 60-63» | claim 1]; and

said first service container being adapted to make use of at least one network lock provided by said service computer and offering to said first service container a predefined interface to said communication network [column 6 «lines 38-45» | column 9 «lines 1-7» | column 10 «lines 1-16» where: Yates' interfaces are comparable in functionality to the network lock and Yates' terminal domain is analogous to the service computer].

19.   As to claims 12-17, Yates discloses said service computer is capable of providing any one or more of several different network locks, with the particular network lock being provided being dependent on at least one of said communication network and said communication means [column 3 «lines 55-63» | column 24 «line 56» to column 25 «line 16» where : Yates discloses adaptors that adjust the interfaces based on the protocols of the communication means].

20.   As to claims 18-20, Yates discloses said service computer further provides to said service container a monitor lock by which said service container informs said service server of at least one condition of said service computer [column 19 «lines 49-57» | column 22 «lines 23-25» : transmitting to the server the user's service usage history | column 24 «lines 14-17»]. Note that the claimed monitor lock and condition are interpreted consistent with Applicant's specification [*US Patent Publication 2002000386*, 0035 describing that a condition relates to the usage of the service computer during the service session].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452